

## **REMARKS**

### **Election Requirement**

Applicants' attorneys regret any confusion that may have arisen from the election filed April 25, 2005. The elected claims are 15 through 36, which are readable on the Examiner designated Species II (Figs. 4A-7B) although in the original election requirement, Figs. 6A-7D were designated as Species III. It is believed that the present Office Action correctly designates the elected species as that shown in Figs. 4A-7B, upon which claims 15-36 are readable, and upon which the Examiner has acted.

Applicant also reiterates and expressly reserves the right to present the non-elected claims, or variants thereof, in continuing applications to be filed subsequent to the present application.

### **35 U.S.C. §103(a) Rejection**

Claims 15-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,440,657 of Essert in view of Japan '742.

Essert discloses a ribbon splicer assembly wherein a grooved splicing means 22 is overlaid by a second splicing means 28 which functions to maintain the fibers in the grooves of means 22. (Column 3, lines 4-20). In addition, Essert's apparatus has means for guiding the ribbon fiber onto the splicing element 22 which comprises ramps 32 and 34, and the ribbon cables are held thereon by wedge shaped, non-movable covers 64 and 66, which are spaced from the ramps (and the ribbons) to permit the ribbons to slide down the ramps into contact with the splice element 22. (See column 5, lines 10-35).

In order to insert the fibers in the channels 26 of element 22, the splicing element 28 is raised by a key 60 and the fibers are aligned with the channels. Essert admits that it may take several attempts to align the fibers properly. (See column 6, lines 17-57).

Japan '742 discloses a ferrule for terminating a ribbon fiber in which a movable wedge member contacts and aligns the fiber of the ribbon with grooves in the ferrule, and the Examiner contends that it would have been obvious to use slidable wedges as shown by Japan '742 in the Essert assembly.

In order for a rejection on obviousness, the prior art must suggest the desirability of the modification of the base reference. In *In re Fritch*, 972 F.2d 1260, 1266; 23 USPQ2d 1780 (Fed. Cir. 1992), the Court stated "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."

In *In re Sang-Su Lee*, 277 F.3d 1338, 61 USPQ2d 1338 (U.S. Ct. of Appeals, Fed. Cir. 2002), the Court stated "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." The Court further stated "a showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding". *Brown and Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 56 USPQ2d 1456 (Fed. Cir. 2000).

In these and many other discussions, it is clear that for any obviousness rejection to be valid, there must be motivation for making the modifications called for in the rejection. In the present rejection, there is no such motivation. The immovable wedge shaped members of Essert, which apparently do not contact the fibers, as pointed out hereinbefore, could not be replaced by the movable wedges of Japan '742, because a different result, not contemplated by Essert, would be achieved. Further, if movable wedges which bear against the fibers were used in Essert, they would not align the fiber because of the presence of members 28 of Essert. There is no suggestion in Essert that wedges such as Japan '742 be used and no motivation to make such a change.

Claim 15 has been amended to make a more patentable distinction from the references, whether taken signally or in combination. Thus, claim 15 now specifies that both the first and second wedges bear against the press the fibers into the grooves when moved toward each other. This is clearly not shown in the Essert reference nor is Japan '742. Claim 15 further calls for at least one of the wedges be movable a distance sufficient to produce optical coupling of the fibers. Neither Essert nor Japan '742 disclose such a limitation. For these reasons, and for reasons of the foregoing discussion of the law, claim 15 is, as amended, believed to be allowable. Claims 16

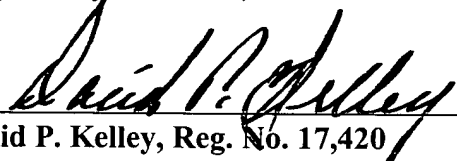
through 31, dependent either directly or indirectly on claim 15 are likewise believed to be allowable.

Claims 32 through 36, directed to the method of coupling optical fibers, are clearly not anticipated by Essert, see, for example, Essert's method as set forth in columns 6, lines 17-57 and are hence believed to be allowable.

**Conclusion**

In view of the foregoing, it is respectfully submitted that all of the claims presently in the case are clearly allowable over the cited art, and favorable action in that regard is earnestly solicited.

Respectfully submitted,

  
\_\_\_\_\_  
David P. Kelley, Reg. No. 17,420

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500